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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,550	06/09/2005	Patrick T. Rigney	ITW-13619	7338
45482 7590 06/09/2008 PAULEY PETERSON & ERICKSON 2800 W. HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195				
EXAMINER				
FERGUSON, LAWRENCE D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
06/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,550

Applicant(s)

RIGNEY ET AL.

Examiner

LAWRENCE D. FERGUSON

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 19, 2008.

Claims 1, 4, 16, 18-19, 24 and 26 were amended and claims 29-30 were added rendering claims 1-12 and 13-30.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 and 14-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claims 1, 18-19 and 26, the phrase, “strapping does not longitudinally split under tension” is indefinite. It is unclear how much tension is needed for the strapping to longitudinally split.

b) In claims 1, 18-19 and 26, the phrase, "low stretchability" is indefinite. The term low is relative and it is unclear what its value is because the stretchability of the strapping is not compared to anything else.

Claim Rejections – 35 USC § 102(b)

5. Claims 1-6, 9-10, 12, 15-17 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Perez et al. (U.S. 6,331,343).

Perez discloses a strapping material (column 2, lines 30-33) comprising a polyethylene terephthalate (polyester) or a polybutylene terephthalate (polyester) (column 3, lines 15-25) which may further comprise less than 30 weight percent of a second polymer, such as linear low density polyethylene (column 3, lines 38-51) as in claims 5-6 and 10. The second polymer appears to be chemically unmodified, as in claim 15. Perez further discloses the relative amounts of the first polymer and second polymer can vary widely from 99:1 (column 4, lines 46-55) as in claims 2-4. The reference discloses the first polymer can be combined with high density polyethylene (column 4, lines 38-45) as in claim 12.

Because Perez discloses a strapping with more than 92% by weight polyethylene terephthalate (polyester) and less than 3% by weight of linear low density polyethylene, it is inherent that the strapping does not longitudinally split under tension and has low stretchability. Additionally, because Perez discloses a strapping with more than 92% weight percent of polyethylene terephthalate (polyester), it is inherent for the polyester material to have an intrinsic viscosity as in claim 9. The claiming of a new use, new

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function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 633 (Fed. Cir.) (1987).

In claim 1, the phrase, "optional additional additives" does not further limit the claims. Because the additional additives are optional, in claims 16-17, the phrases, "wherein the additives comprise an elastomeric material" and "wherein the elastomeric material comprises a styrene block copolymer" also appear to be optional and do not offer a positive recitation to the claims. However, if the limitations of claims 16-17 do provide a positive recitation to the claims, Perez discloses the article further comprises styrene block copolymer (column 15, line 62 through column 16, line 12), which is an elastomeric material.

Concerning claim 29, the surface of the material can be embossed with a pattern (column 13, lines 56-66).

Concerning claim 30, the material can be stretched in each direction up to 2 to 10 times its original dimension in the direction of stretching (column 9, lines 1-10).

Claim Rejections – 35 USC § 103(a)

6. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perez et al. (U.S. 6,331,343) in view of Nishimura et al (U.S. 5,607,183).

Perez is relied upon for instant claim 1 as above. Perez does not disclose the polyester in the strapping can be polyethylene naphthalate or polyethylene isophthalate. Nishimura teaches reinforcing belts (straps) for an article (column 1, lines 23-25) where the straps comprise polyester material such as polybutylene terephthalate, polyethylene naphthalate or polyethylene isophthalate (column 14, lines 19-20 and 37-46). Because Nishimura teaches materials such as polyethylene naphthalate and polyethylene isophthalate are known polyester materials within straps, it would have been obvious to one of ordinary skill in the art to select polyethylene naphthalate or polyethylene isophthalate for the polyester material of Perez to improve the calendar processing ability and compactness of the strapped article (column 14, lines 19-21 and 28-29).

Claim Rejections – 35 USC § 103(a)

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perez et al. (U.S. 6,331,343) in view of Maugans et al (U.S. 6,270,891).

Perez is relied upon for instant claim 1 as above. The reference does not explicitly disclose branched low density polyethylene. Maugans teaches strapping

polymer compositions can be made from thermoplastics such as highly branched low density polyethylene (LDPE) (column 1, lines 44-51 and column 13, lines 5-9). Because Maugans teaches highly branched low density polyethylene is known to be LDPE, it would have been obvious to one of ordinary skill in the art to substitute the linear low density polyethylene of Perez with a branched low density polyethylene of Maugans.

Claim Rejections – 35 USC § 103(a)

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perez et al. (U.S. 6,331,343) in view of Steinkamp et al (U.S. 3,862,265).

Perez is relied upon for instant claims 1 as above. Hughes does not disclose the polyolefin is grafted with a polar monomer, as in claim 14. Steinkamp teaches a strapping article comprising polyolefins (column 4, lines 12-21, column 10, lines 9-12) where the polyolefin is grafted with maleic anhydride or acrylic acid (polar monomers) (column 12, lines 1-5). Perez and Steinkamp are combinable because they are related to a similar technical field, which is strapping material. It would have been obvious to one of ordinary skill in the art to have grafted the polyolefin material of Perez with maleic anhydride or acrylic acid (polar monomers), as taught in Steinkamp, to increase the clarity of the polymer material and to strengthen (harden) the strapping (column 9, lines 33-44).

Claim Rejections – 35 USC § 103(a)

9. Claims 18-24 and 26-28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perez et al. (U.S. 6,331,343).

Perez discloses a strapping material (column 2, lines 30-33) comprising a polyethylene terephthalate (polyester) or a polybutylene terephthalate (polyester) (column 3, lines 15-25) which may further comprise less than 30 weight percent of a second polymer, such as linear low density polyethylene (column 3, lines 38-51) as in claim 23. The reference discloses the article is cut to 5cm wide (column 23, lines 10-11) and typically has a thickness of less than 0.25cm (column 7, lines 49-53). Although Perez does not explicitly disclose a width of 0.5-3cm, the phrase, is construed to include 5 cm, as in claims 21-22.

Because Perez discloses a strapping having a width of about 3cm and a thickness of less than 0.25cm, which consists of polyester and linear low density polyethylene, it is expected that the strapping does not longitudinally split under tension and has low stretchability, as in claims 18-19.

Concerning claim 20, Perez discloses the strapping is uniaxially oriented in at least one major axis (column 2, lines 5-11) , which is construed as including the longitudinal direction.

Perez discloses the article further comprises styrene block copolymer (column 15, line 62 through column 16, line 12), which is an elastomeric material as in claim 24.

Perez does not teach that the elastomeric additive reduces longitudinal stretching resistance of the strapping.

Concerning claim 27-28, the article can be stretched in each direction up to 2 to 10 times its original dimension in the direction of stretching (column 9, lines 1-10).

Claim Rejections – 35 USC § 103(a)

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perez et al. (U.S. 6,331,343) in view of Steinkamp et al (U.S. 3,862,265).

Perez is relied upon for instant claim 19 as above. Perez does not disclose the polyolefin is modified, such as being grafted with a polar monomer, as in claim 25. Steinkamp teaches a strapping article comprising polyolefins (column 4, lines 12-21, column 10, lines 9-12) where the polyolefin is grafted with maleic anhydride or acrylic acid (polar monomers) (column 12, lines 1-5). Perez and Steinkamp are combinable because they are related to a similar technical field, which is strapping material. It would have been obvious to one of ordinary skill in the art to have grafted the polyolefin material of Perez with maleic anhydride or acrylic acid (polar monomers), as taught in Steinkamp, to increase the clarity of the polymer material and to strengthen (harden) the strapping (column 9, lines 33-44).

Response to Arguments

11. The objection of the abstract is withdrawn due to Applicant submitting an abstract of the disclosure on a separate sheet in accordance with 37 CFR 1.52(b)(4).

Applicant's arguments of rejection made under 35 U.S.C. 102(b) as being anticipated by Hughes et al. (U.S. 3,548,048) are moot based on grounds of new rejection.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (U.S. 3,548,048) as evidenced by Heckerman et al (U.S. 4,827,578) are moot based on grounds of new rejection.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (U.S. 3,548,048) in view of Heckerman et al (U.S. 4,827,578) are moot based on grounds of new rejection.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (U.S. 3,548,048) in view of Nishimura et al (U.S. 5,607,183) are moot based on grounds of new rejection.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (U.S. 3,548,048) in view of Maugans et al (U.S. 6,270,891) are moot based on grounds of new rejection.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (U.S. 3,548,048) in view of Steinkamp et al (U.S. 3,862,265) are moot based on grounds of new rejection.

Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Hughes et al. (U.S. 3,548,048) in view of Negi et al (U.S. 4,248,991) are moot based on grounds of new rejection.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/L. Ferguson/
Patent Examiner
AU 1794

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794